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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,309	04/23/2001	Fumiaki Ito	35.C15311	2780

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EXAMINER

RIVERO, MINERVA

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,309

Applicant(s)

ITO ET AL.

Examiner

Minerva Rivero

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 14 is drawn to a "program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 3 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or

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expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

3. Regarding the previous use of Official Notice to assert certain well-known facts, the applicant did not challenge any of the factual assertions made. Hence, such asserted facts are now applicant's admitted own prior art.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1, 3-7, 9-13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Ladd *et al.* (US Patent 6,269,336).

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6. Regarding claims 1, 13, and 15, Ladd *et al.* disclose a document processing apparatus, method and computer-executable program comprising:

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document obtaining means for obtaining a document written in a predetermined markup language from a designated source (Col. 3, Lines 40-42; Col. 11, Lines 42-45);

rule selecting means for extracting rule identification information from the document by said document obtaining means and for selecting a rule from among a plurality of rules based on the extracted rule identification information, each of the plurality of rules specifying respective sections of voice output contents and voice input candidates in the obtained document (Col. 12, Lines 18-20; Col. 16, Lines 12-18; see Fig. 6; Col. 41, Lines 45-50);

document analyzing means for analyzing the document obtained by said document obtaining means based on the rule selected by said rule selecting means to extract voice output contents, voice input candidates, and designation information for designating a next processing object corresponding to each voice input candidate, from the obtained document (Col. 13, Lines 55-59);

voice output means for voice-outputting the voice output contents extracted by said document analyzing means (Col. 9, Lines 3-10);

voice recognizing means for voice-recognizing a voice input by a user (Col. 9, Lines 27-30); and

control means for checking the result of recognition by said voice recognizing means against the input candidates contents extracted by said document analyzing means to control obtaining of a new document by said document obtaining means or next analysis by said document analyzing means based on designation information

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corresponding to an input candidate matching the recognition result (Col. 13, Lines 52-59).

7. Regarding claim 3, Ladd *et al.* disclose said rule identification information is a predetermined attribute value of a predetermined tag (Col. 16, Lines 29-31).

8. Regarding claim 4, Ladd *et al.* disclose said rule selecting means selects a predetermined rule if said rule selecting means cannot extract the rule identification information from the obtained document (*using the default behavior*, Col. 33, Lines 5-11; Col. 14, Lines 29-33).

9. Regarding claim 5, Ladd *et al.* disclose said document analyzing means extracts as the designation information a source from which a next document is obtained (Col. 13, Lines 55-59; Col. 12, Lines 10-14).

10. Regarding claim 6, Ladd *et al.* disclose said document analyzing means extracts an analyzed range of a next document as the designation information (Col. 12, Lines 10-14).

11. Regarding claim 7, Ladd *et al.* disclose said rule selecting means selects a rule based on instructions from the user (Col. 6, Lines 25-36; Col. 24, Lines 12-65).

12. Regarding claim 9, Ladd *et al.* disclose the plurality of rules includes a rule which defines a predetermined attribute value of a predetermined tag as voice output contents, and contents surrounded by predetermined second tags as input candidates, in the document (Col. 18, Lines 32-36; Col. 18, Lines 56-58).

13. Regarding claim 10, Ladd *et al.* disclose wherein in the rule, if the recognition result matches an input candidate, contents ranging from the contents surrounded by said second predetermined tags which correspond to the input candidate up to a third predetermined tag are defined as next voice output contents, and an anchor in the voice output contents is defined as a next input candidate (Col. 16, Line 63 – Col. 17, Line 15).

14. Regarding claim 11, Ladd *et al.* disclose the plurality of rules includes a rule which defines contents ranging from the head of the document to a predetermined tag as voice output contents, and an anchor in the voice output contents as an input candidate (Col. 16, Line 63 – Col. 17, Line 15).

15. Regarding claim 12, Ladd *et al.* disclose the voice input and voice output are performed through a telephone line (Col. 5, Lines 39-42).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ladd *et al.* (US Patent 6,269,336), in view of applicant's admitted prior art.

Regarding claim 8, Ladd *et al.* do not explicitly disclose a priority is given to a predetermined one of the rules based on the user's instructions and the rule based on the rule identification information extracted by said rule selecting means, and said rule selecting means selects the rule to which the priority is given.

However, the admitted prior art discloses that it is well-known in the art of speech recognition to assign priorities to speech models (which are part of the rules specified by the XML document in Ladd *et al.*'s invention) in speech recognition systems in order to make the selection process of required speech models more flexible to the user's requirements.

Therefore it would have been obvious to one ordinarily skilled in the art at the time of the invention to modify the teachings of Ladd *et al.* to assign priorities and

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choose rules based on assigned priorities because this would enable the system to be more flexible to the user's requirements and choose a rule that would best fit the situation.

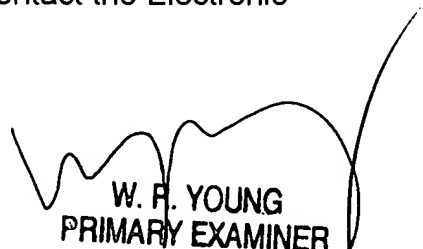
Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minerva Rivero whose telephone number is (571) 272-7626. The examiner can normally be reached on Monday-Friday 9:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR 9/28/05


W. F. YOUNG
PRIMARY EXAMINER